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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,061	05/22/2001	David D. Goodman	03133-005017	8001

7590 05/02/2002
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EXAMINER

CHAN, WING F

ART UNIT PAPER NUMBER

2643

DATE MAILED: 05/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Ne

Office Action Summary

Application No.
09/863,061

Applicant(s)
Goodman

Examiner
Wing F. Chan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 22, 2001
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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1. The present application Serial No. 09/863,061 is a continuation of application Serial No. 09/292,895 filed 4/16/99 now US PAT. 6,236,718 which is a continuation of Serial No. 08/819,120 filed 3/17/97 now US PAT. 5,949,473 which is a R60 continuation of Serial No. 08/431,270 filed 4/28/95 (abandoned) which is a R60 continuation of Serial No. 08/181,562 filed 1/13/94 (abandoned) which is a R60 continuation of Serial No. 08/062,148 filed 5/14/93 (abandoned) which is a FWC of Serial No. 07/688,864 filed 4/19/91 (abandoned) which is a continuation of Serial No. 07/379,751, now US PAT. 5,010,399.

2. As directed by the preliminary amendment filed 5/22/01, claims 1-31 were canceled, new claim 32 was added. Therefore, in the present application only claim 32 is pending. The present claim 32 correspond substantially to the originally presented, reject claim 32 in the parent case (SN 09/292,895, preliminary amendment filed 3/13/00, paper No. 8). In the previous Office actions, claim 32 was rejected as being obvious over various prior art under 35 U.S.C. § 103, and the rejections still stands and are repeated as follow.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claim 32 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Krause (US PAT. 4,918,688).

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Krause discloses a system and method for bi-directional communication of data information using frequencies above the voice band over the two-wire telephone network substantially as claimed. Krause discloses sending data information from a first transceiver to a second transceiver and vice versa. Krause also discloses preventing the transmission of data information from the telephone network to telephone equipments connected to the telephone network, receiving the data information and presenting it at the two transceivers. Krause differs from the claimed invention in not disclosing the data information comprise control information, or the transceivers being called a source of information. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the data information that is sent from the first transceiver to the second transceiver correlates to control information since the second (receiving) transceiver sends back data information based on the received data information from the first transceiver; and at the same token the second transceiver correlates to a source of information as it's sending data information back to the first (requesting) transceiver. Furthermore, the specific content of the data information does not make the claims patentable as the data information in Krause can be any type of data, thus, it would have been further obvious to one of ordinary skill in the art at the time the invention was made to modify the data content in Krause to comprise control data, video data without departing from the scope of Krause's teachings. Thus, the limitations of claim 32 is rendered obvious over Krause as discussed supra.

5. Claim 32 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Fitzgerald (US

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PAT. 4,799,213) in the same manner as Krause as discussed in the above paragraph since Fitzgerald like Krause also differs from the claimed invention in not disclosing the specific data content.

6. Claim 32 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Camarata (US PAT. 4,985,892) in the same manner as Krause as discussed in the above paragraph since Camarata like Krause also differs from the claimed invention in not disclosing the specific data content.

7. Claim 32 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Reichert et al (US PAT. 4,785,448) in the same manner as Krause as discussed in the above paragraph since Reicher et al like Krause also differs from the claimed invention in not disclosing the specific data content.

8. Claim 32 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Decker et al (US PAT. 4,757,495) in the same manner as Krause as discussed in the above paragraph since Decker et al like Krause also differs from the claimed invention in not disclosing the specific data content.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claim 32 is rejected under the judicially created doctrine of double patenting over claim 1 of US PAT. 6,236,718, claims 1-23 of (US PAT.. S. Patent No. 5,949,473 and claims 1-30 of (US PAT.. S. Patent No. 5,010,399. Although the conflicting claims are not identical, they are not patentably distinct from each other because present claim 32 is a broader version of the aforementioned patent claims and are directed to the same common subject matter, as follows: method and system for bi-directional transmission of data information using two-sire telephone network without passing the data information to the connected voice telephone equipments.

11. This is a continuation of applicant's earlier Application No. 09/292,895. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the

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THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:


(703) 872-9314 for facsimile communications (for Technology Center 2600 only).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

13. **Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner W. F. Chan** whose telephone number is (703) 305-4732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached at 703-305-4708.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.


WING F. CHAN
PRIMARY EXAMINER
ART UNIT 2643

WFC